

DETAILED ACTION

Receipt of IDS dated 8-18-09 is acknowledged.

Claims 5-7, 21, 23-24 and 52-56 are canceled. 1-5, 8-20, 22, 25-51 and 57-63 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-18-09 has been entered.

The following rejections replace the previous rejections of record:

Double Patenting

Claims **1-5, 8-51 and 57-63** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345 in view of US 4,710,375 or in view of US 5,486,354.

Instant claims recite a cosmetic composition comprising a binder comprising water and particles of cross-linked elastomeric organosiloxane (phase C), and a particulate phase (phase B), with the ratio of 0.4:1 to 1.8:1 and the ratio of the binder to the phase B is from 1:1 to 2.5:1. The composition of the instant claims comprise

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particulate phase B comprises at least one pearlescent agent, present in an amount ranging from 10% to 50% by weight, relative to the total weight of the composition and has a pasty to pulverulent texture.

The patented claims recite a make-up composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase and the patented composition is also used for the same cosmetic purposes claimed in the instant application. Dependent claims of the cited patent recite the particle sizes of the organosiloxane, aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. Further, the dependent claims of the patent (48-54) recite fillers, nacres and pigments respectively, which are defined by the patent as particulate materials and include the claimed fillers and pigments respectively and include the same materials that are claimed in the instant applications. Furthermore, the patent claims same cosmetic forms or products such as solid foundation powders that read on the claimed pulverulent mixtures, foundation etc., that are within the scope of the instant claims. While the patented claims do not recite the exact ratios of the instant claims, they recite the amounts of the organopolysiloxane and the particulate phase (see claims 11-12 and 33-34), particle sizes and hardness range that is within the claimed ranges and also suggest different consistencies or forms of the cosmetic composition such as powders, sticks. Accordingly, preparing a cosmetic/make up composition of desired consistency or form such as powder or foundation or stick form by choosing the appropriate amounts of the individual components i.e., polyorganosiloxane, particulate phase, water and other components claimed in '345 it

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would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the polyorganosiloxane and the particulate phase because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

With respect to the pearlescent pigments and their amounts claimed in the instant particulate phase, the said patent (see claim 46) recites pigment separate from the aqueous phase but fails to recite pearlescent pigments.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other

forms such as those described in the patented claims of US 345 and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application.

Claims 1- 63 directed to an invention not patentably distinct from claims 1-63 of commonly assigned US 6,689,345. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,689,345, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 8-20, 22, 25-51 and 57-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patents 6,403,704 ('704) or US 6,689,345 ('345) or US 6,565,862('862) each in view of US 4,710,375 or in view of US 5,486,354.

'704 teach cosmetic skin care compositions comprising particles of at least a partially crosslinked elastomeric polyorganosiloxanes suspended in an aqueous phase, wherein the polymer dryness as well as a matte finish to the cosmetic composition when applied (col. 2, L 23- 59). Both instant specification and '704 refer to the same polysiloxane compounds described in JP-A-10/175816 application (mentioned in the instant application) for the suitable polyorganosiloxanes compounds that are suitable for the instant invention, particularly, those sold under the trade names BY-29-122, BY-29-119 (also disclose in the instant specification) (col. 3, L 37-59 & col. 4, L 10-40) having the same hardness and particle sizes recited in the instant claims. For microcrystalline wax of claims 32 -35, see col. 5, L 50-55. For volatile oils of claims 36-38, see col. 4,

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last paragraph through col. 5. For gelling agents of claims 39-43, see col. Col. 6, l 4-40. For the pigments, fillers and nacres (read on instant pearlescent agents) see entire col. 7. '704 teach preparing the composition by a screw extruder mixer and thus meet claimed method of preparing the composition (claims 51-60), where the polyorganosiloxanes is added to water and mixing with the pigment or filler materials that are particulate in nature. '704 further teach the same solid compositions claimed (col. 49-59). '704 do not teach the claimed ratios of the particulate phase and binder. However, '704 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '704 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance.

'862 also teach cosmetic composition comprising the claimed binder and particulate material and for the preparation of the same cosmetic compositions such as those claimed. The disclosure of '862 and '704 are similar in that the former also teach the same polymers as suitable for binder phase, and also teach the fillers, pigments, nacres, fatty phase, waxes and gelling agents etc. '862 also describe the same advantages such as those described by '704 with the composition. '862 fail to teach the claimed ratios or percentages of the components A, B and C. However, '862 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach

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the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. '862 also teach pearlescent agents in an amount of 2-15% (col. 7, L 43-50). Further, '862 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'345 cosmetic compositions comprising the claimed organosiloxane elastomeric polymers (col. 4, L 55 through col. 6, L 67) and are similar to those of '704 and '862. '345 also teach the claimed fatty phase, particle sizes (col. 7), containing microcrystalline wax (col. 8, L 56-65), gelling agents (col. 8, L 38 through col. 9, L 20), particulate pigments, fillers, nacres (col. 9) and the same method of producing the composition (twin screw extruders- col. 10). '345 fail to teach the claimed ratios or percentages of the components A, B and C. However, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58 and teaches etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51). Further, '345 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore, it would have been obvious for one of an

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ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

While US '345 and '704 does not specifically teach pearlescent pigments and their amounts, US 862 teach pearlescent agents in an amount of 2-15% (col. 7, L 43-50), as opposed to instant 10% to 50%. While the amounts of '862 taught overlaps with the instant claimed amounts, one cannot immediately envisage the cosmetic compositions with claimed amounts of pearlescent agents from the composition.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the

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form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other forms such as those described in the cosmetic compositions of US 345, US 862 or US '704 and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

Claims **1-5, 8-51 and 57-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over US EP 1064930 (EP) in view of US 4,710,375 or in view of US 5,486,354 or JP 2000103717 (JP 717, abstract only) in view of EP and one of US 375 or US 354.

The examiner relies on US Patent 6,689,345 for the English translation of EP reference because the US patent 345 relies on the EP application for foreign priority. The teachings of US 345 have been discussed in the preceeding rejection (#4). Accordingly, for the reasons mentioned above, it would have been obvious for a skilled artisan at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness because '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51).

Alternatively, JP (abstract) teaches a solid cosmetic composition having excellent stability to impact even when mixing a large amount of spherical powder of an organopolysiloxane elastomer (abstract). The composition of JP comprises 0.1% to 50% by wt of organopolysiloxane spherical powder having 50-100 or 50-80 JIS hardness and a particle size of 0.1-200 microns. JP teaches preparing the cosmetic in the form of powdery foundation, or other kinds of foundations, rouges etc., and teaches preparing the spherical powder by dispersing organopolysiloxane in water. JP fails to teach the claimed particulate phase B in the composition and the additional components claimed in the instant application i.e., fillers, pearlescent materials, oils, wax, gelling agents etc. of the instant claims.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other forms such as those described in the cosmetic compositions of EP and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references

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are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

It would have been obvious for a skilled artisan at the time of the instant invention to include the cosmetic additives such as fillers, pearlescent materials, oils, wax, gelling agents etc. of EP (US 345) depending on the desired consistency and effect, in the composition of JP because both JP and EP are directed to preparing the same type of cosmetic compositions comprising the same type of organopolysiloxane materials (including hardness and particle sizes) and according to EP the instant claimed materials are conventionally used in preparing the described cosmetic make up compositions such as foundations, powders etc. With respect to the claimed ratios, as explained above, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51) and JP also teaches percentages of organopolysiloxanes, both for preparing the same type of compositions i.e., powdery foundations etc. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides the desired finish and strength.

Further, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products with the organosiloxanes of

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JP containing additives, pigments and fillers of EP, and also incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

Response to Arguments

Applicants did not present any additional arguments with the filing of RCE. However, the arguments presented previously in response to the non-final rejection and also with the after final amendment have been addressed adequately in the previous actions dated 3-18-09 and 6-26-09 and are incorporated herewith. Applicants' previous arguments with respect to the Declaration of 12-8-08 have been addressed previously in the actions dated 3-18-09 and 6-26-09 and are incorporated herewith. Further, the instant claims are now rejected over a new combination of references, as described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner,
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